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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,941	06/25/2001	Theresa A. Burkes	10008291-1	9288

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EXAMINER

BROOKS, MATTHEW L

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/888,941	Applicant(s) BURKES ET AL.	
	Examiner Matthew L. Brooks	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-15 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2005 and 25 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, for example:

Applicant has fixed the reading of the timestamp from memory (claim 2) and outputting of the timestamp in figs, however this was only an example all steps claimed must be shown in flow chart, and many are missing (ie; the step of searching).

Applicant is asked for help in correcting informalities.

Also Fig. 1 is objected to because no "determining" step is present unless the output of fig 2, 32 is the determining step. If so then in Fig 1, after step 24, rather than "END" it should say then to Fig 2 START. Also no lead line indicating "searching".

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112 2nd

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims **1-6, 8-15, 17-26** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Method claims 1-6 and 8-12 were used for example. The remaining claims have the same structural problems and Applicant is asked for help in straightening up the claim due to the repetitiveness and multiplicity thereof.

4. With respect to claim 1 the method step is missing an essential step that of the “occurrence” of the warranty start event; which should likely be between steps (a) and (b).

5. With respect to claim 1(b) there is a lack of antecedent basis “...generating a timestamp with *the* product...” Also the same term is indefinite because a time stamp is generated for the product or within the product. Which is it?

6. With respect to Claim 1 overall it is missing the essential step of “determining the warranty start date” unless is equivalent to storing it on a memory.

7. With respect to claim 8 there is a lack of antecedent basis for “...the network”.

8. With respect to claim 12; it appears that the “detection step” comprises “continuously searching”?

9. Lastly since this is a method for “determining a warranty start date” it is indefinite as to who/what does the determining step, not yet ever claimed.

Claim Rejections - 35 USC § 101

10. **Claims 1-13** are no longer rejected under 35 U.S.C. 101 because the technological arts prong is no longer valid.

Double Patenting

11. **Claims 1-4, 10- 12, and 15** are no longer rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,798,719 (Muta); due to the filing of the disclaimer.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

13. Claims **1-3, 5-6, 8-9, and 12, 15, 17-26** are rejected under 35 U.S.C. 102(e) as being anticipated by Patent No.: 6,519,470 (Rydbeck).

14. With respect to the Method claims 1-6 and 8-12 for example; Claim 1 Rydbeck teaches a method for determining when a warranty for a product/peripheral/wireless communications device begins, equivalent to "warranty start date" further Rydbeck teaches:

- (a) defining a warranty start event (Column 2, 40-43 "first use");
- (b) generating a timestamp with the product after detection of the occurrence of said warranty start event (C7, 59-68 "date stamp occurs at first use date);
- (c) storing said time stamp in memory (C2, 30-35)
- (d) wherein the product is for producing output, and wherein said warranty start event comprises production of a specified quantity of the output (in the terms of a product such as a peripheral/input-output device like a phone the first use is considered output and the first use thereof is a species that falls within the range of a specified quantity of output if the specified quantity of output is equal to one/first use.)

15. With respect to **Claim 2**: Rydbeck discloses

reading said time stamp from memory to determine the warranty start date (C7, 59-63 "looking at the start date").

16. With respect to **Claim 3**: Rydbeck discloses

wherein said memory is internal to the product (C2, 1-3).

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17. With respect to **Claim 5 and 6**: Rydbeck discloses

Obtaining timestamp over a network (C5, 20-37). And the memory where timestamp is stored is remotely located from the product (C5, 20-37).

18. With respect to **Claim 8**: Rydbeck discloses

A product for connection to a network and obtaining a timestamp over the network (C5, 20-37 and C7, 59-69).

19. With respect to **Claim 9**: Rydbeck discloses

Obtaining time stamp over network in appropriate protocol. (C5, 25-35).

20. With respect to **Claim 12**: Rydbeck discloses\

Continuously searching for occurrence of warranty event (C7, 59-68 and C8, 1-5).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
23. Claims **4, 10-11 13-14, and 15-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: 6,519,470 (Rydbeck).
24. With respect to the Method claims 1-6 and 8-12 for example; Claim 1 Rydbeck teaches a method for determining when a warranty for a product/peripheral/wireless communications device begins, equivalent to "warranty start date" further Rydbeck teaches:
- (a) defining a warranty start event (Column 2, 40-43 "first use");
 - (b) generating a timestamp with the product after detection of the occurrence of said warranty start event (C7, 59-68 "date stamp occurs at first use date);
 - (c) storing said time stamp in memory (C2, 30-35)
 - (d) wherein the product is for producing output, and wherein said warranty start event comprises production of a specified quantity of the output (in the terms of a product such as a peripheral/input-output device like a phone the first use is considered output and the first use thereof is a species that falls with in the range of a specified quantity of output if the specified quantity of output is equal to one/first use.)
- Rydbeck shows all of limitations as laid out above and above in 102.
- Rydbeck fails to show obtaining the time stamp from an internal clock, encrypting time stamp while storing, outputting an encrypted timestamp and that the "output" is printed documents.
- The examiner takes Official Notice that obtaining a time for timestamp purposes and encryption of said stamp is old and well established in the business of timestamping

as a convenient way for a business to obtain from a product an appropriate first use date. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of encrypting timestamp in Rydbeck by encryption techniques because the skilled artisan would have recognized that this business practice protects the data from being read, altered and corrupted and is clearly applicable to the time stamping of any type of product. These advantages are well known to those skilled in the art.

With respect to the "output" not being printed documents. With respect to the Application at hand it is abundantly clear that the Applicant has envisioned two embodiments when Examiner turns to the Applicant's Abstract lines 8 and 9; "warranty start events comprise **first use** by the user, and **production of a specified cumulative quantity of product output**. Examiner is of position that the first use of a product, is known with in the art as the start date of a warranty and time stamping thereof if use has occurred in external/internal memory is obvious to one of ordinary skill (as shown by Rydbeck).

It is the later, "warranty start event" that is novel and patentably distinct in the art; that of starting the warranty upon the production of a specified cumulative quantity of output. The problem lies in that if the specified quantity of output is only one, that is the equivalent of a first use.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Rydbeck, which teaches starting the warranty event after a first use, to other products and/or peripherals, if their first use was

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the production of a document or specified output greater than zero because the teaching of the telephone device in Rydbeck is a peripheral and or input/output device and the advantages of starting the warranty after the first use of such a device were well known in the art.

Response to Arguments

25. Applicant's arguments with respect to claims **1-6, 8-15, 17-26** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLB
7/07/2006



DENNIS RUHL
PRIMARY EXAMINER